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10/537,882	06/07/2005	Rembert Fertner	AT 020073	8419
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/537,882
Filing Date: June 07, 2005
Appellant(s): FERTNER ET AL.

Michael Marcin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/16/08 appealing from the Office action
mailed 10/2/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,488,376

Bryant

8-1921

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant USPN 1488376.

As to claims 1 and 8, Bryant discloses a personal care apparatus with an air pump 10, a suction piece 18, an aperture (interior of 18, Figure 3), two suction piece sections 11 (flange 11 has upper and lower sections) designed to exert a radial force on a skin protuberance (lines 70-82); at least two sealing parts 20, 12 between two mutually adjacent suction piece sections and having an airtight connection to the

mutually adjacent suction piece sections in that they both impede the flow of air. Bryant does not disclose a motor for exerting a suction effect on the skin. The suction in the Bryant invention is created manually. However, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent- mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

As to claims 3 and 10, the limitations are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claims 4, 5, 11, and 12, the suction piece sections each have a circular arc shape having a sharp defining edge (Figures 1, 2, and 4).

As to claims 6, 7, 13, and 14, Bryant is silent as to the diametric interval of the two defining edges of the personal care apparatus. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

(10) Response to Argument

Applicant's arguments filed 9/16/08 have been fully considered but they are not persuasive. Applicant argues the Examiner has failed to address the limitation of claim 1 which recites "wherein the suction piece has at least to suction piece sections extending to the suction aperture and defining the suction aperture, said two suction piece sections being radially adjustable. Applicant argues that Bryant teaches a flared mouth made out of either rubber or metal and is of a fixed aperture in contrast to the claimed two suction pieces being radially adjustable. Section 11 of Bryant provides the suction piece, which has upper and lower sections. The claims do not require the section pieces be separate pieces. Therefore, the upper and lower section of suction piece 11 provides the claimed two suction piece sections. Additionally, the claims do not require that the suction piece sections are radially adjustable to one another, just

that they are radially adjustable. Bryant teaches the body portion 18 has threaded lines (lines 50-55), therefore, the suction piece is radially adjustable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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